UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *9-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06/20/2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

2.   Claims 9-22 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

The preamble of claim 9 is miss descriptive because, claim 1 recites "a system

comprising a server <u>with</u> at least one SMS communication interface.....<u>with</u> <u>fixed</u>

<u>telephony terminals....,</u> however these fixed telephony terminals are part of the system

not the server as states in the specification and figures.

Claim 9 also recites the limitation "with fixed-telephony terminals for the reception

from and transmission to said terminals of data relating to their telephone directories",

which indicates that the transmission is between the fixed terminals; however, the same

claim recites the limitation "inputs/outputs which can be connected to the network <u>for the</u>

<u>reception from and transmission </u>to computer, personal assistant or mobile telephone

devices or other synchronization server, of telephone directory or address book data",

however "<u>the reception from and transmission"</u> refers to the transmission function

performed in the previous limitation which is being performed between the terminals.

These two limitation are in conflict with each other.

Claim 9 also recites the limitation "a directory database enabling synchronization

of <u>the data</u> from <u>a directory of a fixed-telephony</u> terminal user with <u>the other types of</u>

terminal which can be connected to the Internet network, and/or enabling backup of the data from <u>a directory of fixed-telephony</u> terminal users", is not clear to which <u>"the data"</u> refers to, is it refer to the data in the limitation "said terminals of data relating to their telephone directories" or to the data in the limitation "address book data" ? also are their two different "directory of a fixed telephony terminal?

Also claim 9 recites the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 10 recites "the system as claimed in claim 9, comprising <u>an input for its link to an internet site</u>" is not clear what does this limitation means, also the preamble of claim 10 is not in consistence with claim 9 which claim 10 depend on. Also it is not clear from the claim language if this <u>input</u> is part of the system or the server.

Claims 11-22 the preambles of these claims are not in consistence with claim 9. Claims will be interpret as best understood by the Examiner.

Claim 12 recites "according to <u>the characteristic of fixed telephony terminals</u>", is not clear because, "the characteristic" indicate that this characteristic has been mentioned before, however it has not been mentioned or defined before. In other words, it is not clear what is characteristic of a fixed telephony terminal.

Claim 14 recites "automatic transmission to a fixed-telephony terminal <u>of the directory modifications</u> <u>if the number of bytes if this modification</u> exceeds a predetermined threshold" this limitation is not clear. Also <u>"the number of bytes"</u> and <u>"the directory modification"</u> have not been mentioned before. The claim also does not clarify

the relation between the directory modification and the number of bytes, is the

modification comprising changing number of bytes?

Claim 15 recites the limitation "the system of claim 9 further comprising a fixed-

telephony terminal in communication with the server, comprising a telephone directory"

is not written in a clear way to verify if the telephone directory is part of the system,

server or the fixed telephony.

Claim 16 recites attaching the directory to SMS subaddress, is not clear weather

this attaching is performed by the server or the telephone, also the claims does not

further disclose the purpose or the advantages if this step.

Regarding claim 17 the phrase "for example" renders the claim indefinite

because it is unclear whether the limitation(s) following the phrase are part of the

claimed invention. See MPEP § 2173.05(d).

 Also claim 17 discloses "addressing the characteristic of its directory", is not clear what

the characteristic of its directory is.

Examiner will interpret the claims as best understood.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 9-10, 12-13, 15 and 17-22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Collette (US 7,020478) in view of Mahajan (US 20040127205).

        Regarding claim 9, Collette discloses, a system (Fig. 1) comprising a server (Fig.

1, el. 40) with:

at least one SMS communications interface (Col. 3, lines 18-22; a server able of

transmit/receive ASMS messages) such as with an F-SMSC server, with fixed

telephony terminals for the reception from and transmission to said terminals of data

(Fig. 1, el. 10 and Fig. 2, el. 13A, Col. 5, lines 20-23)

        inputs/outputs which can be connected to the network for the reception from and

transmission to computer, personal assistant or mobile telephone devices or other

synchronization server (Col. 4, lines 28-43) of a telephone data (Col. 4, lines 52-57;

SMS messages with data/information about requested service).

Collette does not teach that the data in the SMS is related to a directories information or

for each user, a directory database enabling synchronization of the data from a directory

of a fixed-telephony terminal user with the other types of terminal which can be

connected to the Interact network, and/or enabling backup of the data from a directory

of fixed-telephony terminal users.

Mahajan discloses, a system (Fig. 1) comprising a server (Fig. 1, el. 42 and 60), the

server has a SMS interface (Paragraph 0025), with a telephone terminal (Paragraph

0025 and Fig. 1, el. 20) for the reception from and transmission to said terminals of data

relating to their telephone directories (Paragraph 0022-0025), Mahajan also discloses

that the server can be connected to the network for the reception from and

transmission to computer, personal assistant or mobile telephone devices or other

synchronization server (Paragraph 0017, 0019-0022).

Mahajan also discloses for each user, a directory database enabling synchronization of

the data from a directory of a telephony terminal user with the other types of terminal

which can be connected to the Interact network (Paragraph 0017-0022; each subscriber

has a database directory, when an update/delete is made to the directory, the new

information is updated in the telephone terminal through a SMS being sent to the

telephone terminal from the server) and/or enabling backup of the data from a directory

of a telephony terminal users (Paragraph 0018 and 0021; first and second electronic

directory).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the

invention was made to modify Collette with Mahajan , so to include a directory

information into the SMS message and synchronized any updated data in the directory

of the fixed phone, so to improve the system and yield more predictable results.

Regarding claim 10, Collette in view of Mahajan discloses, an input for its link to

an Interact site so that the user can populate the database from a browser (Mahajan:

Paragraph 0021).

Regarding claim 12, Collette in view of Mahajan discloses, a means for

formatting the directory data according to the characteristics of fixed-telephony

terminals (Mahajan: Paragraph 0020-0022; Collette: Col. 2, lines 55-60).

Regarding to claim 13, Collette in view of Mahajan discloses, directory data and

address book data (Mahajan: Paragraph 0016), also discloses reformatting the data

structure based on the data structure used by the telephone (Mahajan: Paragraph 0020

and 0022), and a message with detailed of the manner in which data is structured

therein (Paragraph 0020).

Although Collette in view of Mahajan does not explicitly disclose, wherein the formatting

means comprising a means for selecting the directory data from address book data, it

would have been obvious to one with ordinary skill in the art, at he time the invention

was made that the user can select any field of the directory to reformat/update or to

upload in the directory of the phone based on the data structure used by the phone, so

to have the convenience to update only the data that has been changed.

Regarding claim 15, Collette in view of Mahajan disclose, a fixed-telephony

terminal in communication with the server (Collette: Fig. 2, el. 13A) comprising a

telephone directory (Mahajan: Paragraph 0016) and means for transmitting and

receiving SMS messages (Collette: Col. 3, lines 28-31) wherein the fixed-telephony

terminal comprising:

means for converting data from the telephone directory into SMS messages in order to

transmit them to the server (Mahajan: Paragraph 0022 and 0025) and/or

means for receiving SMS messages from the server (Mahajan: paragraph 0025)

representing directory data, and means for converting these received SMS messages

into directory entries (Paragraph 0020-0025).

Regarding claim 17, Collette in view of Mahajan disclose, wherein the fixed-

telephony terminal further comprising a means for addressing the characteristics of its

directory (Mahajan: Paragraph 0020; the directory information will be structured based

on the data structure used by the phone) i.e. the maximum number of entries, the entry

format, and, preferably, the number of directories, via SMS messages, to the server to

which it can be connected.

Regarding claim 18, Collette in view of Mahajan disclose, wherein the fixed-

telephony terminal further comprising a means for requesting automatic synchronization

or manually-controlled synchronization of the directory (Mahajan: Paragraph 0021).

Regarding claim 19, Collette in view of Mahajan disclose, wherein the fixed-telephony terminal further comprising a memory containing the modifications made to the directory and means for Indicating the need for synchronization (Mahajan: Paragraph 000016 and 0021; a computer comprising a memory) or for automatically initiating synchronization, if the level of fullness of the memory exceeds a predetermined threshold, or if a predetermined period of time has elapsed since the last synchronization.

Regarding claim 20, Collette in view of Mahajan disclose, wherein the fixed-telephony terminal further comprising a means for receiving, from the server, a signal indicating that synchronization is to be carried out (Mahajan: paragraph 0022-0023; the phone receive a message that there is un update, when the phone accept the update it respond with a message confirming the update).

Regarding claim 21, Collette in view of Mahajan disclose, wherein the fixed-telephony terminal further comprising a means so that the synchronization is carried out automatically when the signal is received (Mahajan: paragraph 0022-0023; the phone receive a message that there is un update, when the phone accept the update it respond with a message confirming the update).

Regarding claim 22, Collette in view of Mahajan disclose, wherein the fixed-

telephony terminal further comprising a means for receiving modification data, from the

server, and means for updating the directory with these modification data (Mahajan:

Paragraph 0022-0025).

5.   Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collette

(US 7,020478) in view of Mahajan (US 20040127205) and further in view of McDonald

(20030097382).

       Regarding claim 11, Collette in view of Mahajan discloses, in which the

telephone directory or address book data are preferably accessible using

synchronization(Paragraph 0021).

Collette in view of Mahajan does not explicitly teach that the access to the database

according to the SyncML standard.

       McDonald discloses, synchronization server, in which the telephone directory or

address book data are preferably accessible using SyncML standard (Paragraph 0043-

0045); a synchronization service provided by a synchronization server is provided,

wherein continuous update to files that are shred by a plurality of remote memory stores

phonebooks records store on the phone terminal or any other devices (Paragraph

0044).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the

invention was made to modify Collette in view of Mahajan so to use SyncML standard to

enhance the usage of the system by providing a flexible solution for connecting digital

devices of all kind.

6.   Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collette

(US 7,020478) in view of Mahajan (US 20040127205) and further in view of Ooishi (US

20020062288).

        Regarding claim 14, Collette in view of Mahajan discloses, means for automatic

transmission to a fixed-telephony terminal of the directory modifications (Mahajan:

Paragraph 0021) if a change or modification to the directory took place (Mahajan:

Paragraph 0021).

Collette in view of Mahajan does not teach that the transmission would take place if the

number of bytes if this modification exceeds a predetermined threshold, or if a

predetermined period of time has elapsed since the last synchronization.

However, transmitting a data after a specific period of time is well known in the art.

Ooishi discloses, transmitting of a data after a predetermined time has elapsed

(Paragraph 0090).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the

invention was made to modify Collette in view of Mahajan with Ooishi teaching so to

have the synchronization process continuously, in order to improve the system and yield

more predictable results.

7.   Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collette

(US 7,020478) in view of Mahajan (US 20040127205) and further in view of Halim

(20030092454).

Regarding claim 16, Collette in view of Mahajan disclose, authorization,

authentication and accounting server AAA server, which inherently required an access

code or password in order to access the record (Paragraph 0019-0020).

Collette in view of Mahajan does not disclose wherein the telephone directory is

attached to an SMS subaddress.

Halim discloses, attaching the destination and origination address in the SMS

subaddress (Paragraph 0039).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the

invention was made to modify Collette in view of Mahajan so the terminal will be to

recognize between the terminals connected to the same line.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to MARIA EL-ZOOBI whose telephone number is

(571)270-3434. The examiner can normally be reached on Monday-Friday (8AM-5

PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Curtis Kuntz can be reached on 571-272-7499. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 2614
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